

## REMARKS

Claims 1-4 and 6-9 are rejected. Claims 1, 8 and 9 have been amended. Claims 1-4 and 6-9 are presently pending in the application. Favorable reconsideration in view of the following marks is earnestly solicited.

The basis for the amendment to claims 1, 8 and 9 can be found in Examples 1 through 3F of the specification as originally filed. The amendment to the claims does not raise a new matter or new issues as the limitation is plainly disclosed within the specification.

### **Rejection under 35 U.S.C. § 103(a) over Asgharian et al. in view of Bruiju et al.:**

The Examiner has rejected claims 1-4 and 6-9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,139,646 (Asgharian) in view of U.S. 6,162,393 (De Bruiju) for the reasons set forth on pages 2-3 of the Office Action dated February 5, 2007. The Examiner indicates that Asgharian teaches a contact lens solution of a cationic polymeric preservative and a preservative enhancer of glycerin, sorbitol and a propylene glycol. The Examiner further states that the reference teaches a chloride concentration of less than 0.2 and the use of a buffer, sequestering agent, simple saccharide. The Examiner states that Asgharian fails to teach the concentrations of some of the carriers, but that the determination of optimum proportions or amounts would have been obvious to a person skilled in the art. Applicant urges this rejection as moot in light of this amendment.

The Examiner relies on Bruiju in combination with Asgharian solely for the teaching of decanedioc acid which was previously claimed in cancelled claim 5. As claim 5 is canceled this rejection is moot.

Asgharian relates to improving the stability of liquid enzyme solution containing both covalently modified trypsin and water using organic stabilizers. The stabilizers compete with water in the hydrogen bonding of the liquid enzyme solution to reduce the water-hydrogen bonding necessary for enzyme activity.

The instant invention relates to a solution with a specific combination and concentrations of a preservative enhancer, polyhexamethylene biguanide and chloride.

The inventive solution is effectively preserved while reducing the amount of preservatives deposited on contact lenses.

Asgharian teaches a two component solution where trypsin is an active component in a first component that is combined with the second component. The second component contains sorbitol with a concentration of 1.2 weight/volume. There is no indication that the second solution would be effective as a contact lens solution by itself. Indeed, Asgharian teaches that the second component, the solution, need be combined with the first component containing trypsin to be effective. By contrast, the present invention claims a single component solution that is effective as a contact lens solution. The reference fails to teach this limitation and therefore, fails to teach or suggest all of the claimed limitations.

Additionally, the instant invention demonstrates surprising results. The specific combination and concentrations of compounds claimed by the instant invention provides superior antimicrobial activity. Applicant kindly directs Examiners attention to paragraph [0033] of the specification. The antimicrobial activity of samples with no additive or chloride in excess of the claimed limitations show reduced activity, while the samples containing glycerin, sorbitol, mannitol, inositol and dextrose demonstrated increased activity. Paragraph [0035] of the specification demonstrates the reduced effectiveness of the solution as chloride concentration exceeds 0.2 weight percent. The Examples shown in the specification show surprising results as the specific combination and concentrations of compounds provides improvements over samples outside of the claimed range. Therefore, it is respectfully requested that this rejection be reconsidered and withdrawn.

Applicant respectfully submits that Claims 1, 8 and 9 and all claims that depend therefrom are therefore in condition for allowance.

**Response to Examiners Inherency Argument:**

In the Final Office Action dated July 12, 2007, the Examiner states that the increased efficacy of the specific combination of the claimed invention is the inherent property of the components being used together. Applicant urges this inherency argument is improper as applied to an obvious type rejection.

The doctrine of inherency is not appropriate where, as here, the rejection is one of obviousness under 35 U.S.C. § 103. The Court in *In re Rijckaert*, 28 USPQ2d 1955 (Fed. Cir. 1993) stated: "The mere fact that a certain thing may result from a given circumstance is not sufficient [to establish inherency]." *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) (citations omitted)(emphasis added).

"That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).


As discussed above, the prior art fails to an effective single component solution. As a result, it is submitted that inherency rational may not be applied.

Applicant appreciates the opportunity to call the Examiner but believes that this amendment to the claims and the forgoing remarks fully address the issues raised by the Examiner. On the other hand, the Examiner is invited to call the undersigned attorney if he has any matters to address that will facilitate allowance of the application.

In the event that Applicant has overlooked the need for an extension of time, additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefore and authorize that any changes be made to Deposit Account No.: 50-3010.

Applicant respectfully requests favorable consideration and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
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